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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,979	10/13/1999	LINUS TORVALDS	TRANS22	8219

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EXAMINER	
ELLIS, RICHARD L	
ART UNIT	**PAPER NUMBER**
2183	10

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/417,979	TORVALDS ET AL.	
	Examiner	Art Unit	
	Richard Ellis	2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 1-16 are presented for examination. Claims 17-23 are newly presented for examination.

2. The following is a quotation of the appropriate paragraphs of 35 USC § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-16 are rejected under 35 USC § 102(e) as being clearly anticipated by Lethin et al., U.S. Patent Application Publication 2002/0,147,969.

4. Lethin et al. was cited as a prior art reference in paper number 5, mailed May 13, 2003.

5. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number 7, mailed November 3, 2003.

6. New claims 17-23 are rejected under 35 USC 102(e) as being clearly anticipated by Lethin et al.

7. As to new claims 17-23, they do not teach or define above the invention claimed in claims 1-16 and are therefore rejected under Lethin et al. for the same reasons set fourth in the rejection of claims 1-16, supra.

8. Applicant's arguments filed February 3, 2004, paper number 9, have been fully considered but they are not deemed to be persuasive.

9. In the remarks, applicant argues in substance:

9.1. That: "Lethin fails to teach or suggest the claimed limitation of detecting at intervals whether the interpreter or the translator is operating."

This is not found persuasive because applicant's arguments are applying a significantly narrower definition to the claimed phrase "at intervals" than is present in the claim language itself. Applicant's claim language as written includes absolutely no narrowing definition of the term "at intervals" and as such, any interval, regular or irregular, no matter how created, is an

interval to the extent necessary to read upon the claim language. Because as explained in the last office action, paper number 7, mailed November 3, 2003, Lethin et al. taught detecting when the compiler was running vs. detecting when the interpreter was running (see paragraph 9.1) and because this detection was generated as a result of compilation and/or interpretation of instructions, an "interval" will pass between instances of requests for compilation vs. instances of completions (fig. 29). Therefore, at "intervals" Lethin et al.'s system will detect the compiler as running (indicated by reception of a completion) and at other "intervals" will detect the interpreter as running (indicated by reception of a request). Accordingly, to the overly broad recitation of the invention presented in applicant's claims, Lethin et al. does indeed teach the invention. Applicant is reminded that it is the claim language which defines the invention, not the specification:

Claimed subject matter, not the specification, is the measure of invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11,15 (CCPA 1978).

"It is the claims that measure the invention." *SRI Int'l v. Matshshita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc).

"The invention disclosed in Hiniker's written description may be outstanding in its field, but the name of the game is the claim." *In re Hiniker Co.*, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

"[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

"limitations appearing in the specification will not be read into the claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper'." *Intervet Am., v. Kee-Vet Labs.*, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)(citation omitted).

"it is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim, ... this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous,' we mean a limitation read into a claim from the specification wholly apart from any need to interpret ... particular words or phrases in the claim." *In re Paulsen*, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citation omitted).

9.2. That: "Lethin begins paragraph 626 by stating that the interpreter counts how many times an instruction is executed. As Applicants have previously discussed, counting the

number of times that a particular instruction(s) is executed is a conventional technique that is substantially different from the Applicants non-obvious technique of detecting at intervals whether the interpreter or the translator is operating, maintaining a count based thereon and changing from interpreting to translating a sequence of instructions based on that count"

This is not found persuasive because applicant is arguing that Lethin et al.'s source of intervals with which to count whether the compiler or interpreter were operating differs from applicant's source of the same said interval. However, it is noted that to the extent that any narrowing definition of "interval" is provided by the claim language, the claim language provides no definition as to the source of that said interval. Therefore, although applicant may believe that his source of intervals differs from that of Lethin et al., that difference has not yet been reflected in the claim language.

9.3. That: "Lethin also describes this procedure as a software feedback technique for equalizing the rate of translation requests to the rate of translations completed, in paragraph 625. Lethin's technique is to compare the number of translation requests sent to the translator to the number of translations completed. However, this comparison does not constitute the claimed limitation of "detecting at intervals whether the interpreter or the translator is operating." The claimed "detecting at an interval" detects that at the given interval, either the interpreter or the translator is being used."

This is not found persuasive because as discussed above, applicant is again arguing aspects of the invention which are unstated and undefined in the claim language. As was clearly pointed out in the previous office action, due to the manner of operation of Lethin et al.'s system, completions are provided only due to the execution of the compiler, therefore they indicate that the compiler is running. Requests are provided only due to execution of the interpreter, therefore they indicate that the interpreter is running. Because the interpreter will take some amount of time to create a "request" (because some amount of execution must occur before a "request" is made) an "interval" will pass between indications of execution of the interpreter. By the same manner, because the compiler will take a finite amount of time to produce a translation, "completions" will only be generated after some "interval" of time. Therefore, everything within the Lethin et al. system operates by detecting "at intervals" execution of the compiler and interpreter. As was noted above, applicant's claim language contains absolutely no narrowing definition of the interval, and absolutely no narrowing

definition of the source of said interval. Therefore, any interval, of any size, of any regularity or irregularity, and from any source, is an "interval" sufficient to read upon the claim language.

9.4. That: "Applicants have amended Claim 1 to clarify that the changing is in response to the count reaching a selected maximum. That is, the count (of interpreter usage minus translator usage) reaching a selected maximum is a trigger that initiates the change from interpreting to translating."

This is not found persuasive because as detailed in the previous rejections, applicant's claimed "count" is exactly equivalent to Lethin et al.'s disclosed "requests - completions" shown on figure 29. As seen from cited paragraph 628, when Lethin et al.'s "requests - completions" reaches a selected maximum, the system is adjusted to bias it to either interpret or to compile instructions. Therefore, to the extent that any narrowing claim language exists for this feature, Lethin et al. is changing from interpreting to compiling or from compiling to interpreting based on the count reaching a selected maximum.

9.5. That: "Lethin does not disclose a selected maximum for the count (of interpreter to translator activity), as claimed."

This is not found persuasive because Lethin et al. does indeed teach just such a maximum. See paragraph 628, fourth sentence.

9.6. That: "Lethin fails to make the switch to compiling in response to the count (of interpreter to translator activity) reaching a selected maximum. Rather, Lethin teaches switching in response to the threshold being crossed for the count of the number of times a particular sequence of instructions has been executed. This is because in Lethin a sequence of instructions must have been executed a number of times equal to the threshold in order to trigger the switch from interpreting to translating. Thus Lethin does not teach or suggest changing from interpreting to compiling in response to the count (of interpreter to translator activity) reaching a selected maximum.

This is not found persuasive because again, applicant is arguing the source or derivation of the claimed intervals while failing to amend the claims to state the particular source or derivation of the intervals within the claims themselves. As shown above, Lethin et al. does indeed teach the claimed invention, due to the fact that the claims are claimed more broadly than that to which applicant is entitled.

9.7. That: "Lethin does not teach or suggest the claimed cause and effect condition [of claim 16]".

This is not found persuasive because as detailed numerous times above, applicant's claim language is written in such broad terms that the differences that which applicant argues exist between the invention and Lethin et al. have not in fact been placed within the claim language. Accordingly such differences can not serve to differentiate the claim language from the Lethin et al. reference.

9.8. That: "Claim 17 recites, '... detecting at intervals ...' [and] '... changing from interpreting to translating ...'"

This is not found persuasive because again applicant is simply reiterating the same argument from claims 1-16, which has been shown above to be applicant arguing unclaimed features of the invention which can not serve to differentiate the claims from the cited reference.

10. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 USC 133, MPEP 710.02, 710.02(b)).

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (703) 305-9690. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (703) 305-9712. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Richard Ellis
February 23, 2004

RICHARD L. ELLIS
PRIMARY EXAMINER